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EXAMINER

NGUYEN, JIMMY H

ART UNIT PAPER NUMBER

2629

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/990,498

Applicant(s)

MA ET AL.

Examiner

Jimmy H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,6,8,11,13,14,16-19,21,23,24,26,28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8,11,13,14,16-19,21,23,24,26,28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 02/27/2006. Claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19, 21, 23, 24, 26, 28 and 30 are currently pending in the application. An action follows below:

#### *Specification*

2. The amendment filed 02/27/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The added paragraphs, see page 2 of the amendment, are not supported by the original disclosure because the original disclosure does not teach the personal computer 22 including an indexer 15, a browser screen 72, and etc.. The disclosure, see page 3, paragraph 5, expressly teaches the apparatus comprising an indexer and the disclosure, see page 8, paragraph 25, expressly teaches the whiteboard apparatus 10 is separated from a personal computer. In other words, the indexer is not an element of the personal computer. Further, it is noted to applicant that Fig. 4 should be submitted again for approval.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### *Drawings*

3. The drawings were received on 02/27/2006. These drawings are not acceptable because Fig. 2a introduces new matter. See the specification objection above.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features, "a circle **partially enclosing** the user-drawn marks" of claim 1 (see lines 17-18) and claim 16 (see lines 4-5),

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“removing a circle from the circle region including a circle enclosing or partially enclosing the user-drawn marks” see lines 17-18 and 23-24, of **claim 1**, “removing the circle from the selected portion including a circle enclosing or partially enclosing the user drawn marks, see lines 4-7 of **claim 16**, “a mark-up removal method for removing a user-drawn circle from a marked region including user-drawn notes enclosed by a user-drawn circle and all the steps” of **claim 23**, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Important Notice to Applicants***

5. It is suggested to Applicants to review and to rewrite all claims in order to clearly define the claimed features, e.g., user-drawn marks, a selected portion of the user-drawn marks, a circle

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region, and the white board notes, of claim 1, thereby avoiding the unnecessary objection and rejections below.

***Claim Objections***

6. Claim 1 is objected to because of the following informalities: line 1, “4” should be changed to -- 1 -- or -- 3 -- because claim 4 is cancelled and line 22, “the circle region” should be changed to -- the selected portion --, so as to make this feature consistent with the feature recited in lines 8-10 of claim 1.

Appropriate correction is required.

7. Claim 23 is objected to because of the following informalities: line 4, “the marked region” should be changed to -- the marked-up region --, so as to make this feature consistent with the feature recited in line 3. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19, 21, 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 3, 5, 6, 8, 11, 13 and 14, it is not clear what the applicants means “a selected portion of the user-drawn marks” (see line 9 of claim 1), “the selected portion of the user drawn marks corresponds to a circled region of the whiteboard notes” (see lines 15-17 of claim 1), and “the circle region includes a circle enclosing or partially enclosing the user-drawn marks” (see lines 17-18 of claim 1), i.e., what the user-drawn marks, a selected portion of the

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user-drawn marks, a circle region, the whiteboard notes and the relationship of these features are. Furthermore, independent claim 1 recites “the whiteboard notes” in lines 16-17. There is insufficient antecedent basis for this feature in the claim. Additionally to claim 6, when this claim is read together with claim 1 this claim recites “the circle region includes a circle enclosing or partially enclosing the user-drawn marks” (see lines 17-18 of claim 1) and “the user-drawn marks contain plural circled regions” (see lines 1-2 of claim 6). Accordingly, it is not clear the circled region containing the user-drawn marks or the user-drawn marks containing plural circled regions.

As to claims 16-19 and 21, independent claim 16 recites “a selected portion of user drawn marks” (see line 3) and “the selected portion includes a circle enclosing or partially enclosing the user-drawn marks” (see lines 4-5). Accordingly, it is not clear the user-drawn marks containing the selected portion or the selected portion containing the user-drawn marks. Further, see claim 17.

As to claims 23 and 24, independent claim 23 recites “the mark-up of the image” in lines 7-8. There is insufficient antecedent basis for this feature in the claim.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19, 21, 26, 28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19 and 21, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed feature, “a circle partially enclosing the user-drawn marks” recited in independent claims 1 and 16 (see lines 17-18 of claim 1 and lines 4-5 of claim 16). The original disclosure, see Fig. 2, only expressly discloses a marked-up region 26 comprising user-drawn marks “PDMS 2000 Plan” and a circle enclosing the user-drawn marks. However, the original disclosure does not contain such description and details to the above underlined feature, so as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 26, 28 and 30, the disclosure, when filed, does not fairly convey to one of ordinary skill in the art that applicants had in their possession the claimed feature, “a **plotter for generating at least one of said digital forms** of said user marks selected through said browser screen onto said panel in said physical form” in last two lines of independent claim 26. The original disclosure, specifically abstract and original claims 1 and 3, expressly discloses a digitizer corresponding to a scanner for generating digital information corresponding to the user-drawn marks. Further, the original disclosure, specifically page 4, lines 6-9 and the original claim 22, expressly discloses “a plotter for plotting machine-drawn marks onto said reusable panel using at least one whiteboard pen dispensing erasable ink, wherein the whiteboard notes are plotted based on digital information stored in memory, and wherein said digital information

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corresponds to user-drawn marks.” Accordingly, the original disclosure does not disclose the above underlined feature.

12. Claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19, 21, 23, 24, 26, 28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1, 3, 5, 6, 8, 11, 13, 14, 16-19 and 21, these claims contain the features, “removing a circle from the circle region including a circle enclosing or partially enclosing the user-drawn marks” (see lines 17-18 and line 23 of claim 1) and “removing the circle from the selected region including a circle enclosing or partially enclosing the user-drawn marks” (see lines 4-5 and line 7 of claim 16), which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure, when filed, specifically Fig. 4 and the corresponding description, page 13, line 22 through page 15, line 12, only discloses a method of removing a circle which does not enclose any user-drawn marks. In other words, the original disclosure does not expressly disclose a method of removing a circle **from a circle region** including data, user-drawn marks, or user-drawn notes in the circle region, e.g., “PDMS 200 Plan” as shown in Fig. 5a. Furthermore, when the method as shown in Fig. 4 and described page 13, line 22 through page 15, line 12, applies to a circle region including data and a circle enclosing data, a circle and data are all erased. Further, see the last two steps recited in claim 13,



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which cause all non-background pixels, i.e., data and a circle enclosing data being erased, since data and a circle include non-background pixels. Further, see claim 14.

As to claims 23 and 24, see the rejection above.

As to claims 26, 28 and 30, since the method disclosed in the original disclosure as discussed above is not capable of removing a circle from a circle region including data or user-drawn marks or is capable of removing both the circle and data enclosed in the circle, a header can't be created by the method disclosed by the present application. Accordingly, these claims contain the feature, "an index fro creating at least one header corresponding to said digital forms of said user marks" (see lines 7-8 of claim 26) and "said indexer applying a circled region extraction technique for creating a given said header corresponding to a given said digital form" (see claim 28), which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

13. It is noted to Applicants that due to the rejection under 35 USC 112, first and second paragraphs, the following rejections are based as best understood by the examiner.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 1, 3, 5, 6, 8, 11, 16-19, 21, 26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carau, Sr. (US 6,318,825 B1) hereinafter Carau, and further in view of Weber et al. (USPN: 5,572,651), hereinafter Weber.

As to claims 1, 3, 5, 26, 28 and 30, Carau discloses an integrated apparatus (see Fig. 1) comprising a whiteboard panel (100) for temporary display marks made by inkjet printing mechanism dispensing erasable ink (see col. 2, lines 39-42 and col. 3, line 39); a digitizer or a scanner (image capture means such as a CCD array, col. 2, lines 30-37) for generating digital marks (col. 3, lines 25-36); and a plotter (inkjet printing mechanism, see col. 2, lines 39-42) for providing the whiteboard panel with redisplay capability (see col. 3, lines 36-40). Accordingly, Carau discloses all the claimed limitation except for an indexer, markers, a header, and a browser, as presently claimed.

However, Weber discloses a user using a marker (pen 83, see Fig. 4) to mark a selected text portion corresponding to a circled region (a key object (84, 88), see Fig. 4). Weber also teaches an indexer for associating digital information (data object in the bounding box, e.g., "handwriting recognition is hard", see Fig. 7) with a key object data or user-drawn mark "handwri" included in the circled region (the key object) which is extracted from the digital information (data object in the bounding box) and based at least in part on a selected portion of the user marks (Figs. 4 and 7 show the key objects including data "handwri", "WEBER", and etc., extracted from a digital information (data object in the bounding box 96, 98) and associating with the digital information). Also see Fig. 3, step 58, Fig. 5 and col. 13, lines 13-16 and col. 14, lines 3-21. Further, Weber teaches a browser for providing an interface for the user to select the key objects stored in the memory (see Fig. 9). Further, Weber discloses the selected portion of

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the user-drawn marks corresponding to a circled region of the displayed text and the circled region including data or user-drawn mark, such as “Weber”, “handwri”, and etc., and a circle enclosing data (see Figs. 4, 7 and 9). Weber also teaches an index method comprising a step of extracting a circled region (key objects 84, 88, 92, and etc., see Figs. 4, 7, and 9), a step of removing a circle from the circle region prior to associating the digital information (Fig. 9 shows that a circle corresponding to “JACK’s” is removed prior to associating with the digital information). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an indexer, a browser, and markers (it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to recognize that the markers for use with Carau’s whiteboard must be dry erase ink, see Carau, col. 3, lines 36-40), in the Carau apparatus, in view of the teaching in the Weber reference, because this would provide the user the ability to retrieve user-produced information with special information designators which are used as access (indexing) mechanism into the user-produced data, without recognition or interpretation of the data, as taught by Weber. See col. 3, line 45 through col. 4, line 20 for additional benefits. Accordingly, the combination of Carau and Weber discloses all the claimed limitations except for a header.

However, Weber further teaches that the data (handwrit, Weber, Jack’s) of the key object (84, 88, 92, and etc.) can be inserted many places in a text (see Figs. 4, 7 and 9). While Weber may not exemplify the key object being used as a header, one of ordinary skill in the art would have found it obvious to use the key object as a header in accordance with a particular application.

As to claim 6, Weber also teaches the user-drawn marks containing plural circle regions (see Figs. 4, 7 and 9). Accordingly, the combination of Carau and Weber obviously discloses the invention of claim 6.

As per claim 8, as discussed above, Carau in view of Weber discloses the header based on a selected portion of the user-drawn mark. Accordingly, the difference between the combination of Carau and Weber and the invention of claim 8 is a step of constructing recognized text using handwriting recognition on the circled region. However, Official Notice is taken that both the concept and the advantages of constructing recognized text using handwriting recognition on the handwriting text are well-known and expected in the art. It would have been obvious to have included the handwriting recognition in the Carau apparatus because this would allow other participants to easily read the text corresponding to the handwriting text.

As per claim 11, Weber also teaches the apparatus comprising an input display (32) for allowing a user to select key objects and an output display (28) for outputting a plurality of key objects (see Figs. 2 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide an output display in the Carau apparatus, in view of the teaching in the Weber reference, because this would provide the user simultaneously to view plural information.

As per claims 16 and 18, these claim are rejected on grounds presented in the rejections of claims 1 and 5 above.

As per claim 17, this claim is rejected on grounds presented in the rejection of claim 6 above.

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As per claim 19, this claim is rejected on grounds presented in the rejection of claim 8 above.

As per claim 21, this claim is rejected on grounds presented in the rejections of claims 8 and 11 above.

### ***Response to Arguments***

16. Applicant's arguments filed 02/27/2006 have been fully considered but they are not persuasive because as follows:

With respect to independent claims 1, 16 and 26, Applicants argue that Weber does not disclose “removing a circle from the circled region prior to associating the digital information”, see page 24, lines 3-5 and page 25, lines 1-2. Examiner disagrees because (i) as discussed in the rejection above, Weber expressly teaches a circle enclosing key object data “handwri” from the circle region (key object 88, see Figs. 4 and 6) prior to associating the data object in the bounding box “Handwriting input-based systems ... to computer” (see Figs. 4, 7 and 9) and (ii) claim 26 does not recite the above underlined feature. Applicants further argue that Weber does not disclose “the header is extracted from digital information created from user drawn notes such that **remaining** digital information is associated with the header”, see page 24, lines 6-8.

Examiner disagrees because at least all independent claims do not recite a feature, “remaining digital information is associated with the header”.

17. It is noted to applicants that the drawing objection with respect to feature, “indexer”, in the Office Action dated 11/25/2005, is hereby withdrawn because it is understood that an indexer located in the whiteboard apparatus, as supported by the specification, page 3, paragraph 5.

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18. It is noted to applicants that the claim objections in the Office Action dated 11/25/2005, are hereby withdrawn in view of the amendment to the claims.

19. It is noted to applicants that the rejection under 35 USC 112, second paragraph, in the Office Action dated 11/25/2005, is hereby withdrawn in view of the amendment to the claims.

20. It is noted to applicants that the rejection under 35 USC 112, first paragraph, to claims 13-15 and 23-25, in the Office Action dated 11/25/2005, is hereby withdrawn in view of the amendment to the claims.

21. It is noted to applicants that the rejection under 35 USC 112, first paragraph, with respect to the feature, "an indexer" in the Office Action dated 11/25/2005, is hereby withdrawn in view of the support in the original disclosure.

22. It is noted to applicants that the rejection under 35 USC 112, first paragraph, with respect to claim 29 in the Office Action dated 11/25/2005, is hereby withdrawn in view of the cancellation of this claim.

23. It is noted to applicants that the rejection under 35 USC 102(e) to claims 23-25 in the Office Action dated 11/25/2005 is hereby withdrawn in view of the amendment to these claims.

### ***Conclusion***

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

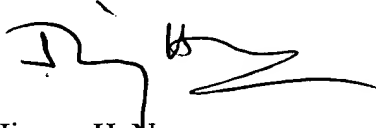
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675.

The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN  
May 9, 2006



Jimmy H. Nguyen  
Primary Examiner  
Technology Division: 2629



DISAPPROVED.  
JHW  
5/5/06

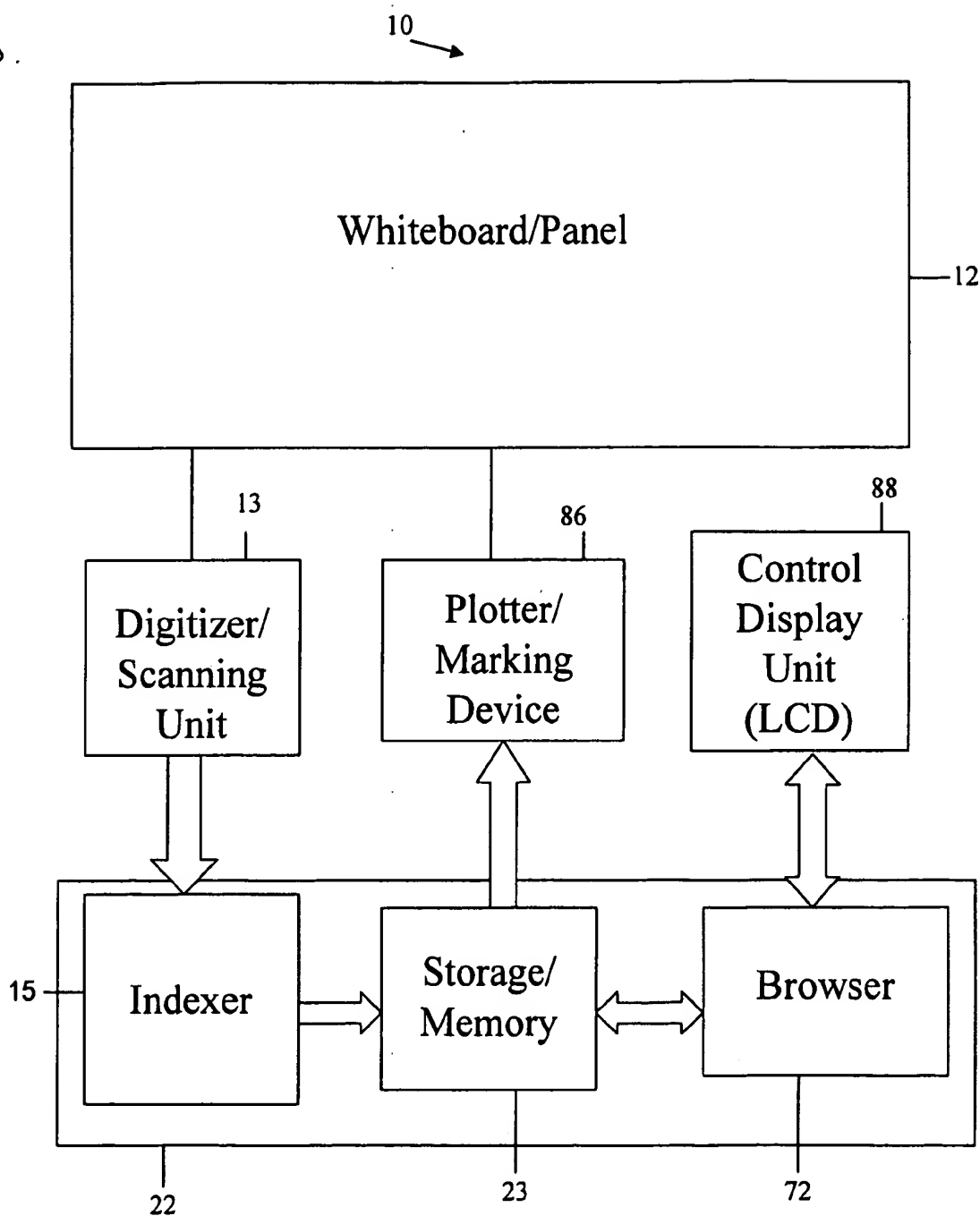


FIG. 2a